

## **REMARKS**

Claims 1-9 are pending in this application. Claim 10 is canceled without prejudice to or disclaimer of the subject matter recited therein. By this Amendment, the specification, claims and drawings are amended. No new matter is added.

### **I. Personal Interview**

The courtesies extended to Applicants' representative by Examiner Luong at the interview held September 30, 2004, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

### **II. Election/Restriction**

Applicant confirms the election of species I, Fig. 3, claims 1-10 and acknowledges that claim 1 is generic as indicated in the outstanding Office Action.

The Examiner indicated he does not believe revising Figs. as proposed would show inner and outer layers. Also indicated that he would reject any new drawing as new matter.

### **III. Drawings**

The drawings are objected to under 37 C.F.R. §1.83(a). Applicant submits that Figs. 1 and 2 are amended in reply to the objection, and therefore request that the objection to the drawings be withdrawn.

New Figs. 5-8 are added. Support for new Figs. 5 and 6 is provided in original Figs. 1-4, page 2, lines 15-18; page 2, lines 1-2; and page 4, lines 14-19. Support for new Figs. 7 and 8 is provided in original Figs. 1-4; page 3, lines 4-9; page 4, lines 7-12 and original claims 4-19. Thus, Figs. 5-8 do not contain new matter.

### **IV. Specification**

The disclosure is objected to for failing to designate each claimed feature with a reference numeral character in the specification. The specification is amended in reply to the

objection. Support for the amendments to the Specification may be found in the specification as cited in the discussion in the Drawings section above. Applicant requests the objection to the disclosure be withdrawn.

The Specification is also amended to comport with the changes to the Figures. Support for these changes may be found in the original specification as identified above.

**V. Claim Rejections Under 35 U.S.C. §112**

Claims 4-9 are rejected under 35 U.S.C. §112, first paragraph. Specifically, the Office Action points out that claims 4-9 "call for the inner and outer layers of different formulations of a flexible, resilient material." The Office Action alleges that the drawings do not show the inner and outer layers. However, as indicated above, the drawings are amended, including new Figs. 7 and 8, in reply to the objection to designate the inner and outer layers with reference numbers. Support for the amendments to the drawings is discussed above.

The Office Action also states that "it is unclear as to how Applicant makes/uses the inner and outer layers and attaches them together to form the claimed hand grip." However, as such a method is not recited in the pending claims, there is no basis for which to object to the claims for this reason under 35 U.S.C. §112, first paragraph. Thus, Applicant respectfully requests the rejection of claims 4-9 under 35 U.S.C. §112, first paragraph, be withdrawn.

**VI. Claim Rejections Under 35 U.S.C. §102**

Claim 1 is rejected under 35 U.S.C. §102(b) as anticipated by EP0671315 to Larson et al. (Larson). The rejection is respectfully traversed.

Applicant asserts that Larson does not disclose each and every feature recited in the rejected claim as originally filed, or as currently amended. For example, the Office Action does not disclose a hand grip adapted for non-rotatable fitting onto a motorcycle handlebar end section, the hand grip comprising *inter alia* a hollow cylindrical body having a first open end, an opposing second end, and an annular flange projecting radially outwards at the first

open end, the cylindrical body also having an external surface formed with a plurality of projections distributed thereover, said projections progressively decreasing in base area and in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body.

The Office Action alleges that Larson discloses a hand grip adapted for fitting onto a motorcycle handlebar as recited in unamended claim 1. However, Larson relates to a nubbed grip for a rotatable bicycle gear shifter (see the title of Larson). Thus, Larson does not relate to a hand grip adapted for fitting onto a motorcycle, as recited in unamended claim 1 or a non-rotatable hand grip as recited in the claim as amended. Rather, Larson specifically provides nubbed grips for hand rotatable bicycle gear shifters having longitudinally elongated groups of nubs (Abstract of Larson).

The Office Action also alleges that Larson discloses projections 114 progressively decreasing in height from adjacent the flange 126 to adjacent the second end 120 so as to provide an external taper to the body, as recited in original claim 1. However, Larson fails to disclose projections progressively decreasing in base area and in height from adjacent flange to adjacent second end as recited in claim 1 as amended. Rather, as shown in Figs. 9-11 of Larson, each of the nubs is cylindrically shaped and although the heights of the nubs vary, the base area of the cylinder does not change as the height of the nub changes. Accordingly, Larson does not disclose each and every feature recited in rejected claim 1. Thus, Applicant respectfully requests the rejection of claim 1 under 35 U.S.C. §102(b) be withdrawn.

#### **VII. Claim Rejections Under 35 U.S.C. §103**

Claim 2 is rejected under 35 U.S.C. §103(a) as unpatentable over Larson. The rejection is respectfully traversed.

Applicant asserts that claim 2 is allowable for at least its dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein.

For example, the Office Action admits that Larson does not teach the external diameter of the cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end, as recited in the rejected claim. However, the Office Action alleges that "it is common knowledge in the art at the time the invention was made to form the external diameter of Larson's cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end in order to maximize the amount of torque which may be transmitted from the rider to the hand grip."

To support the allegation of "common knowledge" the Examiner relies on Larson and cites page 3, lines 1-3 in support of the allegation. Applicant notes that page 3, lines 1-3 of Larson recites "The present invention provides technical advantages in that it offers a comfortable grip for the rider's hand which nonetheless maximizes the amount of torque which may be transmitted from the rider to the gear shifter even in muddy or other adverse conditions." Thus, the relied upon section of Larson in no way imbues "common knowledge" to those of ordinary skill in the art to form the external diameter of the cylindrical body to be reduced by less than 5mm from an area adjacent to the flange to an area adjacent to the second end of the cylindrical body. Rather, Larson merely indicates that a comfortable grip which maximizes the amount of torque may be received from the gear shifter described therein. Thus, an assessment of basic knowledge in common sense that is not based on any evidence in the record lacks substantial evidence support. See MPEP §2144.03 citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ 2d 1693, 1697 (Fed. Cir. 2001). Accordingly, Applicant asserts that the Office Action fails to provide a proper basis for the rejection of claim 2.

The Office Action further alleges that "the size or dimension of the external diameter of Larson's cylindrical body would have been a matter of choice of design since the claimed structures and functions they perform are the same as the prior art." However, as indicated

above, there is no description of size or dimension of the external diameter of the bicycle gear shift of Larson recited in the applied reference. As original disclosure of the claimed feature, it cannot be alleged that the structures in Larson perform the same function as the feature recited in rejected claim 2. Furthermore, as Larson relates to a hand rotatable gear shift for a bicycle, the structure of Larson does not perform the same function as the claimed motorcycle handgrip. As Larson does not disclose or suggest an external diameter of the cylindrical body reduces by less than 5mm from adjacent the flange to adjacent the second end, Applicant request the rejection of claim 2 under 35 U.S.C. §103(a) be withdrawn.

Claims 1-3 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Design Patent D284259 to Oury. The rejection is respectfully traversed.

Applicant asserts that Oury does not disclose or suggest each and every feature recited in original claim 1 or in claim 1 as amended. For example, Oury does not disclose or suggest a hand grip adapted for a non-rotatable fitting onto a motorcycle handlebar end section, the hand grip comprising *inter alia*, ... projections progressively decreasing in base area and in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body.

Although the Office Action rejects claims 1-3 and 10 over Oury, the Office Action admits that Oury discloses projections progressively increasing in height from adjacent the flange to adjacent the second area. The Office Action then alleges that it is common knowledge in the art at the time the invention was made to decrease, instead of to increase, the height of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the grip.

Applicant submits that "it is never appropriate to rely totally on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." See MPEP §2144.03 citing In re Zurko, 258 F.3d at 1385, 59 USPQ 2d

at 1697. As the Office Action fails to provide evidentiary support for such common knowledge, Applicant submits that such a rejection is improper.

The Office Action further contends that although Oury's projections progressively increase instead of decrease in height from adjacent the flange to adjacent the second end, that the reversal/rearrangement of the height of Oury's projections would have been a matter of choice of design since the claims structures and the function they perform are the same as the prior art.

Applicant submits that as Oury merely discloses ornamentation on the cycle handle grip, that no function of such ornamentation can, or may be, claimed. Rather, by definition, a design application cannot claim a function, but rather is merely for ornamentation. Furthermore, the decrease in height of the projections from adjacent the flange to adjacent the second end is not merely a design choice as such a decrease in height provides the external taper to the body as recited in the rejected claims. Thus, increasing the height of the projections, as in Oury actually "teaches away" from the claimed subject matter.

Furthermore, as clearly provided in the specification "by making the region adjacent the flange 14 somewhat thicker, particularly making this extra thickness from the soft rubber compound, extra cushioning on the rider's hand is provided in exactly the region of greatest pressure and greatest wear, i.e., below the arch formed by thumb and forefinger. Also because there is more material, this region does not wear down, split and fail as quickly as hitherto in the case of substantially constant external diameter grips." Thus, the arrangement of the projections as recited in the claims is not merely design choice, but provides the structure necessary to overcome the deficiencies of known motorcycle grips.

Regarding claim 2, the Office Action alleges that Oury teaches the invention substantially as claimed and admits that Oury does not teach an external diameter of the cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the

second end. However, the Office Action again alleges that it is "common knowledge" to form the external diameter as recited in claim 2. However, as stated above, it is never appropriate to rely solely on common knowledge in the art without evidentiary support on the record. Furthermore, to imbue one of ordinary skill in the art with knowledge of the invention when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome where in that which only the inventor taught is used against its teacher. W. L. Gore and Associates v. Garlock, Inc. 721 F.2 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Accordingly, Applicant respectfully requests the rejection of claims 1-3 and 10 under 35 U.S.C. §103(a) be withdrawn.

Claims 4-7 are rejected under 35 U.S.C. §103(a) as unpatentable over Oury in view of Applicant's admitted prior art. The rejection is respectfully traversed.

Applicant asserts that claims 4 and 7 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Additionally, as Applicant's admitted prior art does not overcome the deficiencies of Oury discussed above, Applicant requests the rejection of claims 4 and 7 under 35 U.S.C. §103(a) be withdrawn.

Claims 4, 5, 7 and 8 are rejected under 35 U.S.C. §103(a) as unpatentable over Oury in view of U.S. Patent 4,416,166 to Jannard et al. (Jannard). The rejection is respectfully traversed.

Applicant asserts that dependent claims 4, 5, 7 and 8 are allowable for at least their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Additionally, as Jannard does not overcome the deficiencies of Oury, Applicant respectfully requests the rejection of claims 4, 5, 7 and 8 under 35 U.S.C. §103(a) be withdrawn.

Claims 6 and 9 are rejected under 35 U.S.C. §103(a) as unpatentable over Oury in view of Jannard, and further in view of U.S. Patent 5,261,665. The rejection is respectfully traversed.

Applicant asserts that claims 6 and 9 are allowable for their dependency on independent claim 1 for the reason discussed above, as well as for the additional features recited therein. For example, Applicant asserts that the combination of references fails to disclose or suggest a hand grip ... wherein the inner layer is of substantially constant external diameter and the outer layer tapers in its external diameter.

The Office Action alleges that Downey teaches an inner layer 12 being of substantially constant external diameter while the outer layer 14 is tapers in its external diameter in order to provide better gripping for a rider's hands. However, as Downey relates to a golf club grip, Applicant submits that Downey does not teach such a structure "in order to provide better gripping for a rider's hand" as alleged in the Office Action.

Additionally, there is no motivation or suggestion in any of the references to combine the teachings of a golf club grip with either the teachings of Oury or Jannard. For example, each of Oury and Jannard related to cycle hand grips to fit over a handlebar of a cycle. In contrast, Downey relates to golf club grips. Thus, one skilled in the art of cycle grips would not look to the teachings of the golf club art to achieve the structure recited in the rejected claims. Accordingly, Applicant respectfully requests the rejection of claims 6 and 9 under 35 U.S.C. §103(a) be withdrawn.

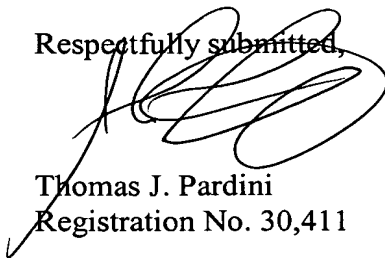
#### **VIII. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-9 are earnestly solicited.



Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Amended Abstract  
Replacement Sheet  
Added Sheet

Date: November 3, 2004

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**Amendments to the Drawings:**

The attached replacement drawing sheet makes changes to Fig. 1 and replaces the original sheet with Figs. 1 and 2.

The added sheet shows new Figs. 5-8.

Attachment: Replacement Sheet

Added Sheet